IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT Application of:

Mark J. STEFIK et al.

) Art Unit:

Divisional Filing Date: February 7, 2001

RECEIVED

Filed:

February 7, 2001

Divisional Application of Serial No. 08/948,893

APR 1 7 2001

For

SYSTEM FOR CONTROLLING THE

DISTRIBUTION AND USE OF RENDERED DIGITAL TO 3600 MAIL ROOM

WORKS THROUGH WATERMARKING

INFORMATION DISCLOSURE STATEMENT

Director of Patents and Trademarks Washington, D.C. 20231

February 7, 2001

Dear Sir:

In accordance with the provisions of 37 C.F.R. § 1.56 and 37 C.F.R. §§ 1.97-1.99, it is requested that the references listed on the attached Form PTO-1449 be made of record in the above-identified application. Copies of the references are submitted herewith in accordance with 37 C.F.R. §§ 1.98(a).

The above information is presented so that the Patent and Trademark Office may, in the first instance, determine any materiality thereof to the claimed invention. See 37 C.F.R. 1.104(a) concerning the PTO duty to consider and use any such information. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that this reference be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

The Commissioner is hereby authorized to charge fees under 37 CFR 1.16 and 1.17 which may be required, or credit any overpayment, to Deposit Account No. 19-2380.

Respectfully submitted,

Jason H. Vick

Registration No.45,285

Attorney Docket No. 111325-45 NIXON PEABODY LLP 8180 Greensboro Drive, Suite 800 McLean, VA 22102

Telephone: (703) 790-9110

NVA169795.1

Sheet

1

4

PTO/SB/08A (08-00)

111325-45

Approved for use through 10/31/2002. OMB 0651-0031 U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number Complete if Known Substitute for form 1449A/PTO Application Number INFORMATION DISCLOSURE February 7, 2001 Filing Date STATEMENT BY APPLICANT Stefik et al. First Named Inventor (use as many sheets as necessary) Group Art Unit Examiner Name

Attorney Docket Number

Evamir	Cite	U.S. Patent Document		Date of Publication of Cited	Pages, Columns, Lines, Where Relevar
Examiner Initials*	No.1	Number Kind Code ²	Name of Patentee or Applicant of Cited Document	Document MM-DD-YYYY	Passages or Relevant Figures Appear
		(if known)			
	ļ	3,263,158	D.W. Bargen et al.	07-26-1966	
		4,529,870	Chaum	07-16-1985	
		4,658,093	Hellman	04-14-1987	
		4,924,378	Hershey et al.	05-08-1990	
		4,932,054	Chou et al.	06-05-1990	
		4,937,863	Robert et al.	06-26-1990	
	1	4,953,209	Ryder, Sr. et al.	08-28-1990	
		4,961,142	Elliott et al.	10-02-1990	
		4,977,594	Shear	12-11-1990	
		5,010,571	Katznelson	04-23-1991	
	<u> </u>	5,014,234	Edwards, Jr.	05-07-1991	
		5,023,907	Johnson et al.	06-11-1991	
		5,047,928	Wiedemer	09-10-1991	
		5,050,213	Shear	09-17-1991	
		5,058,164	Elmer et al.	10-15-1991	
		5,103,476	Waite et al.	04-07-1992	
		5,113,519	Johnson et al.	05-12-1992	
		5,146,499 '	Geffrotin	09-08-1992	
		5,159,182	Eisele	10-27-1992	
		5,191,193	Le Roux	03-02-1993	
		5,204,897	Wyman	04-20-1993	
		5,235,642	Wobber et al.	08-10-1993	
		5,247,575	Sprague et al.	09-21-1993	
		5,260,999	Wyman	11-09-1993	
		5,263,157	Janis	11-16-1993	
		5,263,158	Janis	11-16-1993	
		5,291,596	Mita	03-01-1994	
		5,339,091	Yamazaki et al.	08-16-1994	
		5,432,849	Johnson et al.	07-11-1995	
		5,438,508	Wyman	08-01-1995	
		5,504,814	Miyahara	04-02-1996	
		5,530,235	Stefik et al.	06-25-1996	
		5,530,759	Braudaway et al.	06-25-1996	
		5,629,980	Stefik et al.	05-13-1997	
		5,708,717	Alasia	01-13-1998	
		5,745,569	Moskowitz et al.	04-28-1998	
		5,748,783	Rhoads	05-05-1998	
		5,761,686	Bloomberg	06-02-1998	
		5,768,426	Rhoads	06-16-1998	
		5,825,892	Braudaway et al.	10-20-1998	
-		5,943,422	Van Wie et al.	08-24-1999	

Substitute for form 1449A/PTO			C	Complete if Known		
INFODM	TION DI	SCI OSLIBI	Application Number			
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)			1700 D.4.	February 7, 200 IDFCE	/ 4 L	
			First Named Inventor	Stefik et al.		
			Group Art Unit			
			Examiner Name	APK 1 / 2	UU	
Sheet 2	of	7 4	Attorney Docket Number	111325-45		
				70 3600 MAII	- mu u	

FOREIGN PATENT DOCUMENTS							
Examiner Initials	Cite	Foreign Patent Document	Name of Patentee or	Date of Publication of Cited Document MM-DD-YYYY	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶	
		Office ³ Number ⁴ (if known					
		0 332 707 A1	EP	09-20-1989			
		GB 2 236 604 A	UK	04-10-1991			
		WO/92 20022	PCT	11-12-1992			
		WO/93 01550	PCT	01-21-1993			

OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS					
Examiner Initials	Cite No.1	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.)., date, page(s), volume-issue number(s), publisher, city and/or country where published.	T²		
,		Clark, P.C. and Hoffman, L.J., "Bits: A Smartcard Protected Operating System," Communications of the ACM, November 1994, Vol. 37, No. 11, pp. 66-70, and 94.			
		Ross, P.E., "Data guard", Forbes, June 6, 1994, pp 101.			
·		Saigh, W.K., "Knowledge is Sacred," Video Pocket/Page Reader Systems, Ltd., 1992.			
		Kahn, R.E., "Deposit, Registration And Recordation In An Electronic Copyright Management System," Corporation for National Research Initiatives, Virginia, August 1992, pp. 1-19.			
		Hilts, P., Mutter, J., and Taylor, S., "BOOKS While U Wait," <i>Publishers Weekly</i> , January 3, 1994, pp. 48-50.			
		Strattner, A., "Cash register on a chip' may revolutionize software pricing and distribution; Wave Systems Corp.," Computer Shopper. Copyright, April 1994, Vol.14; No.4; pg.62; ISSN 0886-0556.			
		O'Conner, M.A., "New distribution option for electric publishers; iOpener data encryption and metering system for CD-ROM use; Column," CD-ROM Professional, Copyright, March 1994, Vol. 7; No. 2; pg. 134; ISSN: 1049-0833.			
		Willett, S., '"Metered PCs: Is your system watching you?"; Wave Systems beta tests new technology,' <i>InfoWorld</i> , Copyright, May 2, 1994, pg. 84.			
		Linn, R.J., "Copyright and Information Services in the Context of the National Research and Education Network ¹ ," <i>IMA Intellectual Property Project Proceedings</i> , January 1994, Vol. 1, Issue 1, pp. 9-20.			

Complete if Known Substitute for form 1449A/PTO Application Number INFORMATION DISCLOSURE February 7, 2001 Filing Date STATEMENT BY APPLICANT Stefik et al. RECEIVED First Named Inventor (use as many sheets as necessary) Group Art Unit Examiner Name APR 17 2001 Sheet 3 of Attorney Docket Number 111325-45 OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS **TO 3600 M**AIL**I**ROOM Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the Cite Examiner item (book, magazine, journal, serial, symposium, catalog, etc.)., date, page(s), volume-issue number(s), publisher, city and/or country where published. Initials' Simmel, S.S., and Godard, I., "Metering and Licensing of Resources: Kala's General Purpose Approach," IMA Intellectual Property Project Proceedings, January 1994, Vol. 1, Issue 1, pp. 81-110. Kahn, R.E., "Deposit, Registration and Recordation in an Electronic Copyright Management System," IMA Intellectual Property Project Proceedings, January 1994, Vol. 1, Issue 1, pp. 111-120. Tygar, J.D., and Bennet, Y., "Dyad: A System for Using Physically Secure Coprocessors," IMA Intellectual Property Project Proceedings, January 1994, Vol. 1, Issue 1, pp. 121-152. Griswold, G.N., "A Method for Protecting Copyright on Networks," IMA Intellectual Property Project Proceedings, January 1994, Vol. 1, Issue 1, pp. 169-178. Nelson, T.H., "A Publishing and Royalty Model for Networked Documents," IMA Intellectual Property Project Proceedings, January 1994, Vol. 1, Issue 1, pp. 257-259. European Search Report for Corresponding European Application 95308422.5 Flasche, U. et al., DECENTRALIZED PROCESSING OF DOCUMENTS, Comput. & Graphics, Vol. 10, No. 2, 1986, pp. 119-131. Mori, R. et al., SUPERDISTRIBUTION: THE CONCEPT AND THE ARCHITECTURE, The Ttransactions of the IEICE, Vol. E 73, No. 7, 1990, Tokyo, JP, pp. 1133-1146. Press Release From Electronic Publishing Resources, Inc. (EPR) entitled "National Semiconductor and EPR Partner for Information Metering/Data Security Cards", dated March 4, 1994. Weber, R., "Metering Technologies For Digital Intellectual Property," A Report to the International Federation of Reproduction Rights Organizations, October 1994, pp. 1-29. Weber, R., "Digital Rights Management Technology", October 1995. Perritt, Jr., H.H., "Permissions Headers and Contract Law," IMA Intellectual Property Project Proceedings, January 1994, Vol. 1, Issue 1, pp. 27-48.

Substitute for form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)					Complete if Known			
					Application Number			
					Filing Date February 7, 2001			
					First Named Inventor	Stefik et al.		
					Group Art Unit			
					Examiner Name			
Sheet	4	of 4		4	Attorney Docket Number	111325-45		
				OTHER PRIOR AF	RT – NON PATENT LITERATURE D	DOCUMENTS		
Examiner Initials	Cite No.1	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.)., date, page(s), volume-issue number(s), publisher, city and/or country where published.				T²		
			ch," II			Header Descriptors: A Dynamic ngs, January 1994, Vol. 1, Issue 1,		
-	Sirbu, M.A., "Internet Billing Service Design and Prototype Implementation," IMA Intellectual Property Project Proceedings, January 1994, Vol.1, Issue 1, pp. 67-80.							

Examiner	Date	
Signature	Considered	

^{*}EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

¹ Unique citation designation number. ² See attached Kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

¹Unique citation designation number. ² Applicant is to place a check mark here if English language Translation is attached.